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3625

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,034

Applicant(s)

CUE ET AL.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 March 2004, Amendment B, has been entered.

Response to Amendment

By Amendment B of 22 March 2004, applicant cancelled claims 3, 20, 21 and 58. Applicant amended claims 1, 4, 11, 15, 22, 24, 26, 28, 41, 56 and 59.

Claims 1-71 are pending and will be examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 26, 41 and 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant amended these claims to include the limitation

...storing configuration data in a database usable to arrange at least a portion of the vendor's custom-store web page for the use of group members ***wherein the configuration data is independent of the vendor such that the configuration data is solely determined by the custom-store administrator...***

The disclosures are silent on that would be "...configuration data is *independent of the vendor* such that the configuration data is *solely determined* by the custom-store administrator..." Fig. 6 and related text show that an administrator may change configuration data elements. For example, the disclosures, page 11, line 27-page 12, line 16, state:

Fig. 6 illustrates an example of an external administrator web page which allows for the easy creation of the configuration data for the custom store web pages. In this example, the web page lists a number of different arrangements, each arrangement including a system description 120 that allows the administrator to type in a description title, display order 122 which allows the administrator to set the order of the display of the recommended systems, a product info URL 124 which allows for use of the customized web page to describes the recommended system, a "can be configured" box 126 indicates whether the system configuration can be modified by the purchaser. Also an "Edit" button 130 allows the administrator to modify the elements in the recommended system. Elements can be added or subtracted from the recommended system. A "Delete" button 132 allows the entire recommended system to be removed. The page shown also includes an "Add New System" button 138 which allows the creation of a new recommended system. The "Add New System" page (not shown) includes a list of different products which can be selected to create the recommended systems (virtual bundles).

The system also includes a preview of the recommended system page in which a mock-up of the system page in the custom store is shown to the administrator. Once the configuration is suitable, the administrator publishes the changes to the custom store using the "Publish" option in the web page.

Fig. 6 shows a number of configuration data elements that are usually determined by a vendor. For example, POWER MAC and MACINTOSH are registered

trademarks of Apple Computer Inc.¹ An administrator may input some of this and other configuration data after the data is provided to him by a vendor. However, configuration data cannot be "...independent of the vendor...solely determined by the custom-store administrator..." as claimed. Similarly, vendors influence prices of their products to some extent, since vendors sell within profit boundaries, price points, discounts, margins, etc.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 26, 41 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims were amended to include "...by a custom-store-administrator for a group other than a vendor...wherein the configuration data is independent of the vendor such that the configuration data is solely determined by the custom-store administrator..."

The term **administrator** is indefinite because the disclosures appear to use the word "administrator" in several contexts, including:

administrator (page 2, line 16, page 5, line 6, step 106),
custom-store administrator,
custom-store-administrator,
custom store administrator for the group,
custom store administrator for a group other than the vendor,
custom store administrator for the University of X, item 82 (page 8, line 3),
external administrator,
external custom store administrator (page 6, line 4).

¹ For others, please see <http://www.apple.com/legal/appletmlist.html>.

The disclosures also appear to use the word “external” in several contexts, including external administrator, external organization, external computer (customer computer **36** and custom store administrator computer **40**).

The Examiner believes that all of the above terms refer to the same single entity. For purposes of this examination, the Examiner will treat the above terms as synonyms related to a single entity.

The term “...**producing** the custom-store web page...” is confusing and is not further explained in the disclosures. The term appears to refer to **displaying** a web page and will be interpreted as such.

The phrase “...wherein the configuration data is independent of the vendor such that the configuration data is solely determined by the custom-store administrator...” is confusing.

In claims 1, 26, 41, 56, and dependent claims 3, 4, 7-10, 23, 31, 32, 43, 45-47, 54, 58, 60-62 and 69, the term **configuration data** is indefinite in that the disclosures do not define what constitutes configuration data, particularly configuration data that is “...*solely determined* by the custom-store administrator...”

Please note a similar rejection in a previous office action, which states:

The custom-store-administrator computer handles configuration data and databases that, among other things, enables creation of pages with vendor product information. For example:

- configuration data allows the creation of virtual bundles of **products** for purchase from the custom web page (claim 7).
- configuration data allows the prevention of the selection of certain **products** by group members from the custom web page (claim 8).
- configuration data affects the **product** display (claim 9).
- configuration *data* affects the custom store web page **product** display order. (claim 10)

For purposes of this examination, the term "not associated" will be given its broadest reasonable interpretation to include any type of association.²

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn (US 6,058,373) in view of *Henson* (US 6,167,383).

Blinn discloses a system where multiple vendors may present their products for sale to customers. Blinn discloses that administrators who are not vendors may solely determine *some* configuration data may. See, for example, at least Col. 12, lines 15-Col. 15, line 12. Blinn discloses that global configuration controllers (applicant's administrators) use configuration data to produce web pages for custom stores. Custom stores present these web pages to customers (applicant's members of a group other than a vendor).

Like applicant, Blinn also discloses that merchants may define *some* configuration data. See, for example, at least Col. 14, line 9-Col. 17, line 35. This feature is similar to applicant's system, where database 26 contains vendor-provided data that defines custom stores. Database 36 contains items 46 (template data), 50 (instantiation data) and 52 (administration data). Vendors provide data that is stored in database 36. The data includes template data, including base prices, basic display and discount tiers.

² Office Action of 21 October, 2003, pages 3-4, emphasis in original.

Blinn discloses the limitations of applicants' claims, and permits merchants, groups and organizations to create customized virtual stores on the Internet from models and templates stored in a server's databases. The customized web pages provide a virtual store with its own unique look and feel, as determined by the merchant's administrator.

Administrators may access and update store fronts from their computers, using the HTTP protocol, which transmits URL information from clients to a centralized server (see at least Col. 6, line 20-Col. 7, line 50). Administrators use server software and merchant data to instantiate web pages without vendor input. Configuration data permits administrators to define properties and relationships for products and how the products are displayed on a custom store's pages.

Product properties may include entries for each item, including quantity, color, size and models, item discount, item price, etc. (see at least Col. 2, lines 19-28). Blinn discloses the use of "product families", that is, products that may be bundled together for marketing purposes, creating what applicants refer to as virtual bundles.

Blinn discloses that security and access to various environments (production, development and post-development environments) may be determined via a portion of the URL. See at least Col. 14, line 55 - Col. 15, line 54.

Blinn *does not* specifically disclose that groups that use his invention may include colleges and universities. *Henson* allows customized web stores to identify what he refers to as "customer sets", according to what link a customer executed to get to the online store. A store's configuration data may be used to determine what part of an

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online store a customer gets to see. Customer sets, according to *Henson*, may include individual customers, businesses, organizations, federal government, etc. See at least Col. 14, lines 19-61.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made combine Blinn and Henson to include colleges and universities among the groups that create customized web stores. One of ordinary skill in the art at the time the invention was made would have been motivated combine Blinn and Henson to include colleges and universities among the groups that create customized web stores for the obvious reason that, like government groups, educational organizations may wish to standardize hardware and software that is used by their students. This tendency is very obvious when one registers for a course. For example, students in a calculus course would normally be asked to purchase a specific textbook. While it may be possible to attend classes and learn with another textbook, or a different edition of the same textbook, both students and teachers would suffer from the lack of standardization.

Blinn and *Henson* do not use the term “non-existent” to describe aspects of his inventory. *Henson* discloses a validation warning module, which provides customers with warnings concerning product compatibility and upgrade issues. *Henson* also describes dynamically setting flags that identify critical properties of particular products, such as when a product requires a long lead-time. See at least Col. 8, line 7-Col. 9, line 8. Compatibility refers to the degree to which a computer, an attached device, a

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data file or a program can work with or understand the same commands, formats or language as another.³

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include software that checks and identifies products that are non-existent (i.e., no longer available). One of ordinary skill in the art at the time the invention was made would have been motivated to include software that checks and identifies products that are non-existent for the obvious reason that selling non-existent or incompatible products may lead to customer dissatisfaction and loss of business.

Blinn and *Henson* do not specifically state that "...configuration data is independent of the vendor such that the configuration data is solely determined by the custom-store administrator..." as in applicant's latest amendment.

However, the specific relationship between vendor and administrator computer does not patentably distinguish the claimed system. Further, the recited statement of intended use, that the custom-store-administrator computer is adapted to provide configuration data to the server system, and that the server system being adapted to use the configuration data to arrange at least a portion of the custom-store web page for the use of group members, the configuration data being stored in the database do not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to adapt a client machine such as custom-store administrator computer in the system taught by Blinn and *Henson*

³ Definition of Compatibility, MICROSOFT PRESS Computer Dictionary.

because the subjective interpretation of the use does not patentably distinguish the claimed invention.

Further, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The storing and producing steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive and store from a client computer any type of data and produce a custom-store web page because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

Applicant's arguments filed 22 March 2004 have been fully considered but they are not persuasive.

Applicant argues that amended claims 1, 26, 41 and 56 are not anticipated or rendered obvious by either Blinn or **Henson** because neither reference teaches or suggests that "...configuration data...is solely determined by the custom store administrator..." Applicant argues

...neither reference teaches or suggests that the configuration data provided to the server system from the custom store administrator computer is solely determined by the custom store administrator for the group.

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...Accordingly, there is no teaching or suggestion to separate the administrator computer from the vendor because the administrator and vendor are the same entity. The merchant (i.e., vendor) has control over the ordering process such that an administrator is not needed.

Similarly, **Henson** does not teach or suggest having a separate administrator computer that provides configuration data independently of the vendor ...

There is no teaching or suggestion in **Henson** that the administrator computer is separate from the vendor.

...As described in the currently pending independent claims, the administrator computer for the group has no connection to the vendor.

...On the other hand, both Blinn and **Henson** describe systems wherein the vendor has control over the options and purchases available to groups and users.

...neither Blinn nor **Henson** teach that the configuration data generated by the administrator is independent of the vendor.

As in a previous amendment, Applicant states that the administrator computer for the group has no connection to the vendor:

As described in the currently pending independent claims, the administrator computer for the group has no connection to the vendor. This allows the group to independently set prices and options for the products sold on the vendor's web site. This independence allows the custom store administrator to provide for the needs of the group without undue influence from the vendor. On the other hand, both Blinn and **Henson** describe systems wherein the vendor has control over the options and purchases available to groups and users.

In response to these arguments, neither Blinn nor **Henson** restrict how their client/system functions may be distributed among various parties. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allocate responsibilities and functions according to business models and needs.


Further, an analysis of the various claims as a whole reveals that nonfunctional descriptive material is being recited. A determination of how this descriptive material is being used in the claim as a whole reveals that the material carries little patentable weight and does not patentably distinguish the invention from prior art.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **James Zurita**
Patent Examiner
Art Unit 3625
12 June 2004


Jeffrey A. Smith
Primary Examiner